

Attorney Docket No. 103864.133 US3
Serial No. 10/777,114

REMARKS

In the Office Action, the Examiner noted that claims 55-56 (presumably a typo regarding claims 1-2) are pending in the application, and that claims 55-56 are rejected.

By this Amendment, claims 55-56 have been amended, claims 57-79 have been added, and no claims have been cancelled. Therefore, claims 55-79 are pending in the application. The amendments to the claims and new claims, are supported by the specification and figures. Accordingly, no new matter is believed to have been introduced in the present application.

The Examiner's rejections are traversed below.

Rejection Under 35 U.S.C. Section 103

Claims 55-56 stand rejected under 35 U.S.C. Section 103 as being unpatentable over Lasher et al. combined with Wilson, Pearson and/or McDonald. Applicant respectfully disagrees.

The Examiner admits that Lasher et al. does not disclose a storage table having a stoppage mechanism with an open/closed position and/or functionality. The Examiner contends, however, that Wilson includes a stoppage mechanism, and that McDonald teaches a gantry mechanism.

Applicant disagrees in that Wilson and McDonald cannot be combined with Lasher et al., and even if combined, the proposed combination does not result in the currently claimed invention.

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In particular, Wilson merely discloses an ejection mechanism for the same single-dose medication that is not at all patient specific and associated with a specific order. (Column 2, lines 20-35). In addition, Wilson describes a "dispensing mechanism" that involves the "clamping/unclamping" of packages held within the device (column 1, line 50). No such action, motion, or device is relevant to the presently claimed invention.

McDonald relates to a system for filling single dose orders using storage racks and supply stations. (Column 5, lines 8-32). McDonald is therefore irrelevant to the present invention where a prescription contains multiple doses and is part of a complete patient order. In addition, McDonald relates to a hospital unit dosing concept geared to a daily dispensing system, not an automated prescription filling system as described in the subject matter sought to be patented. Further, McDonald is restricted to dealing with two dimensional packages that are a standardized "card" with a punched hole so that the cards can be hung on the "hooks" that make up the "...locations on the storage rack." (column 3, line 20). In contrast, the subject matter sought to be patented deals with three dimensional packages (bottles or cartons).

In addition, the overall functionality of McDonald is different that the present invention. For example, McDonald describes a "stocking system" that includes items coming in, items going out, and some items being "returned for re-use" (column 2, line 10). The subject matter sought to be patented is a "transfer system" (claim 55), where items come in and go out, but are not "returned for re-

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use". Further, McDonald uses a vacuum device to transfer one tablet/capsule at a time (column 5, line 25 through 45), which is again not at all related to the present invention.

Pearson relates to a mobile cart where the medication containers stored in the cart are accessible by a nurse only in response to a patient ID code entered by the nurse. Pearson describes a portable cart that a nurse would wheel around to different beds on the same hospital floor. Specifically, the Pearson patent describes a concept that starts with a "bulk supply" of tablets/capsules and results in a unit dose for a particular hospital patient. In contrast, the subject matter sought to be patented describes an "automated prescription system" that starts with prepackaged medications, and results in completed orders (each containing one or more prescriptions) that are ready to be sent to patients.

Applicant has further amended the claims to provide the appropriate scope of protection that Applicant is seeking, and to make express what Applicant considers to be inherently claimed.

For example, with respect to Claim 55, without conceding that the cited prior art discloses any of the elements of the present invention, Applicant respectfully submits that the prior art does not show or suggest the combination of limitations in claim 55, when claim 55 is interpreted as a whole.

For example, claim 55 recites the following, in combination, a "bottle transfer system, comprising: a plurality of storage locations, each storage location having a top side and a bottom side; and a stoppage mechanism disposed on the bottom side of each of the plurality of tubes, the stoppage

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mechanism having an open position and a closed position." Claim 55 also recites a "a first transport mechanism obtaining a bottle and feeding the bottle to one of the plurality of storage locations via the top side thereof, wherein the bottle is held by the one of the plurality of tubes when the stoppage mechanism is in the closed position; and a second transport mechanism moving the stoppage mechanism from the closed position to the open position."

Claim 55 also recites "a computer system coupled to the first and second transport mechanisms and capable of identifying a storage location, wherein the computer system is configured to instruct the first transport mechanism to transfer the one or more bottles corresponding to a patient specific order to one or more of the plurality of storage locations, wherein the computer system is further configured to instruct the second transport mechanism to control the stoppage mechanism of the one or more of the plurality of storage locations from the closed position to the open position when the one or more bottles corresponding to the patient specific order has been transferred to the one or more of the plurality of storage locations and are ready for dispensing with other components of the patient specific order, including at least one of another bottle, a package and patient specific literature corresponding to the patient specific order."

Accordingly, Applicant submits that the combination of limitations recited in claim 55 patentably distinguishes over the prior art cited by the Examiner. Withdrawal of this rejection is respectfully requested.

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In addition, Applicant respectfully submits that claims 56-79 also patentably distinguish over the prior art for the specific combination of limitations recited in each of the claims, when each claim is interpreted as a whole. Withdrawal of the rejection of these claims is respectfully requested.

For example, new Claim 67 recites, in combination, "a bottle transfer system, comprising a plurality of storage locations, the plurality of storage locations storing a bottle corresponding to a patient specific prescription order, said plurality of storage locations including a stoppage mechanism having an open position and a closed position." Claim 67 also recites "a first transport mechanism obtaining the bottle and transferring the bottle to one of the plurality of storage locations, wherein the bottle is held by the one of the plurality of storage locations when the stoppage mechanism is in the closed position; and a second transport mechanism responsively connectable to the stoppage mechanism to transition the stoppage mechanism from the closed position to the open position." Claim 67 also recites "a computer system coupled to the first and second transport mechanisms and capable of identifying a storage location, wherein the computer system is configured to instruct the first transport mechanism to transfer the one or more bottles corresponding to a patient specific order to one or more of the plurality of storage locations, wherein the computer system is further configured to instruct the second transport mechanism to control the stoppage mechanism of the one or more of the plurality of storage locations from the closed position to the open position when the one or more bottles corresponding to the patient specific order has been transferred to the one or more of the plurality of storage locations and are ready for dispensing with other components of the patient specific order including at least one of another bottle, a package and patient specific literature corresponding to the patient specific order."

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Accordingly, Applicant submits that the combination of limitations recited in claim 67 patentably distinguishes over the prior art cited by the Examiner. Withdrawal of this rejection is respectfully requested.

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CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

In addition, each of the combination of limitations recited in the claims includes additional limitations not shown or suggested by the prior art. Therefore, for these reasons as well, Applicants respectfully request withdrawal of the rejection.

Further, there is no motivation shown to combine the prior art cited by the Examiner, and even if these teachings of the prior art are combined, the combination of elements of claims, when each is interpreted as a whole, is not disclosed in the Examiner's proposed combination. As the combination of elements in each of the claims is not disclosed, Applicants respectfully request that the Examiner withdraw the rejections.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present

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in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would

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recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

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AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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